



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,096	03/06/2001	Carl-Magnus A. Andersson	015185/027 2568	2737

7590 07/15/2003

Pillsbury Winthrop LLP  
Intellectual Property Group  
50 Fremont Street  
San Francisco, CA 94105-2228

EXAMINER

PATEL, SUDHAKER B

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/800,096	ANDERSSON ET AL.
Examiner	Art Unit	
Sudhaker B. Patel, D.Sc.T ch.	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). .

## Status

1)  Responsive to communication(s) filed on 15 May 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1,2,4-9,11-49 and 53 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1,2,4-9,11-49 and 53 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21 . 6)  Other: \_\_\_\_\_ .

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 5/15/03 has been entered.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 5/15/03 as paper # 21 is being considered by the examiner. A signed copy of the PTO Form 1449 is enclosed with this communication for applicants' record.

3. After further review and reconsideration, this application is not ready for the allowance for the reasons stated below.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1,2,4,5,6,8,9,11-13,14 are rejected under 35 U.S.C. 102(e) as being anticipated by Berk Scott et al(WO 2000059497, also cited as U.S.P. 6399619 filed 6/4/2002, claiming priority to U.S. Provisional Application Sr. No. 60128174 filed 4/6/1999., also cited as Chemical Abstract DN 133:296372).

The compounds of instant claims with Formulae I, II with variables as defined bellow encompass the ref. '497 compounds:

Ar1 =Phenyl(substituted);  
Ar2 =Phenyl(substituted);  
R =Straight chain acyclic organyl group;  
W =Oxygen.

Compound with CAS RN # 301230-89-7 (= 1-pyrrollidineacetic acid, .alpha.-cyclohexyl-3-[[4-[[[(3,4-piperidinyl)methyl-4-phenyl], read onto instant claims.

Compound with CAS RN # 30123-90-0 also read on to instant claims. This compound has Ph-(CH<sub>2</sub>)<sub>3</sub>- instead of Ph-(CH<sub>2</sub>)<sub>2</sub>- in compound listed earlier.

#### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,2,4,5,6,8,9,11-13,14 are rejected under 35 U.S.C. 102(b) as being anticipated by A. Neville et al(WO 9738665, also cited as Chemical Abstract DN 127:358860). See compounds of scheme 4a On page 82; compounds of scheme 25 on page 112; and compounds of scheme 29 on page 116.

The compounds of instant claims with Formulae I, II with variables as defined below encompass the ref. '665 compounds:

Ar1 =Phenyl(substituted);  
Ar2 =Heterocycle(1,3-diazole)(substituted);  
R = Cyclic organyl group(=Phenyl);  
W =Oxygen;  
Y1/Y2 =Bond or CH2 ;  
X1/X2 =Bond or CH2.

Compound with CAS RN 198648-44-1(= 1H-Imidazole-1-acetamide, 5-[(4-cyanophenyl) methyl]-N-(phenylmethyl)-N-(1-phenyl-4-piperidinyl)-, hydrochloride) in encompassed by the claims.

***Claim Rejections - 35 USC § 102***

7. Claims are rejected under 35 U.S.C. 102(b) as being anticipated by Mobilio et al (U.S.P. 521 6165, also cited as Chemical Abstract DN 120:106792).

The compounds of instant claims with Formulae I, II with variables as defined below encompass the ref. '665 compounds:

Ar1 =Phenyl(substituted by Quinolinyl-CH2-);  
Ar2 =Aryl(substituted);  
R = Alkyl;  
W =Oxygen;  
Y1/Y2 =Bond or CH2 ;  
X1/X2 =Bond or CH2.

Compound with CAS RN # 150514-43-5 ( Benzenepropanamide, N-(1-butyl-4-piperidinyl)-N-[[4-[(7-chloro-4-quinolinyl)amino]phenyl]methyl] is encompassed by the instant claims. See compounds of claims 1-18, especially claim 7 in column 22 lines 47-49.

Compound with CAS RN # 150514-42-4 is a monohydrochloride of CAS RN RN # 150514-43-5.

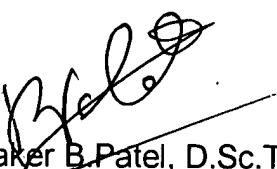
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is 703 308 4709. The examiner can normally be reached on 6:30 to 5:00 pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund J. Shah can be reached on 703 308 4716 or Sr. Examiner Mr. Richard Raymond at (703) 308 4523.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 4556 for regular communications and 703 308 4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235.

  
Sudhaker B. Patel, D.Sc.Tech.  
July 11, 2003.

  
BRUCK KIFLE, PH.D.  
PRIMARY EXAMINER